



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,159	09/28/2005	Koki Tanaka	52433/820	3164
26646	7590	06/04/2008	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			LAVILLA, MICHAEL E	
ART UNIT	PAPER NUMBER			
	1794			
MAIL DATE	DELIVERY MODE			
06/04/2008	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/551,159	TANAKA ET AL.	
	Examiner	Art Unit	
	Michael La Villa	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 March 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 September 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20080317</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

1. In view of applicant's amendments to the withdrawn Claims 4-7, applicant requests rejoinder upon a determination of the allowability of Claim 1. Since Claim 1 is not presently found allowable, rejoinder is not presently warranted.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
3. A person shall be entitled to a patent unless –
4. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. JP 2000-290730 for the reasons of record in the Office Action mailed on 10 October 2007.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. JP 2000-290730 in view of Fujita et al. JP 2000-005751 for the reasons of record in the Office Action mailed on 10 October 2007.

Response to Amendment

9. In view of applicant's amendments and arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 10 October 2007. Rejection is withdrawn.
10. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Suzuki of the Office Action mailed on 10 October 2007. Applicant argues that the present invention pertains to a specific density of oxide particles, but this density is not claimed. Applicant argues that an internal oxide layer of several microns converts to an average particle size of greater than that claimed. However, it would appear that this conversion is dependent on presumed density of oxide particles which is not claimed. Applicant argues that an internal oxide layer of several microns causes cracks and that the objects of having the oxide layer for Suzuki and for applicant are different. While these observations may be correct, applicant appears to show by Figure 2 of Attachment A that Suzuki's method includes the same range of H₂O/PH₂ ratios notwithstanding also being satisfied with ratios outside the range identified by

applicant as desired. Suzuki appears to be concerned with having an adequate internal oxide layer thickness comparable to applicant's when Suzuki teaches nearly identical lower limit ratio and the corresponding range upwards to applicant's upper limit. Applicant points to other distinctions between Suzuki and applicant in terms of processing conditions at the bottom of page 8 of applicant's Response. However, it is unclear how these differences necessarily result in differences in the internal oxide layer or in the later formed oxide particles in the plating layer. Applicant points to a distinction in technical ideas with respect to the basis for oxide formation in Suzuki and applicant. While this may be correct, it is unclear how it necessarily manifests itself in terms of differences in resulting oxide particles and dimensions as claimed. Rejections are maintained.

11. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Suzuki in view of Fujita of the Office Action mailed on 10 October 2007. Applicant points out various differences between applicant's technology and that of Fujita. Since Fujita is only relied upon for demonstrating the desirability of complex phases for improving strength and ductility and the corresponding motivation to include them in the sheet of Suzuki, the distinctions are not deemed germane to refuting the obviousness of including those complex phases in Suzuki.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael La Villa/
Michael La Villa
Primary Examiner, Art Unit 1794
1 June 2008